

REMARKS

At the outset, Applicants' representative wishes to thank Examiner Jarrett for the careful consideration of the present application that is evident in the outstanding Office Action.

As requested, a new Abstract is submitted herewith. The new Abstract is exactly 148 words.

Claims 1-36 were rejected under §101 as being directed to non-statutory subject matter. Reconsideration and withdrawal of these rejections are respectfully requested.

As the Examiner will note, claim 1 has been amended so as to render its subject matter statutory under 35 USC §101. For example, claim 1, as amended, clearly defines an embodiment of the present invention that is squarely within the technological arts. For the Examiner's convenience, the recitations in amended claim 1 that are drawn to such technological arts are highlighted below. As the Examiner can readily see, such recitations (**bolded and underlined**) are an integral part of the definition of the claimed embodiments and cannot be construed as merely reciting a field of use and/or a nominal recitation of technology.

1. A **computer implemented method** of managing a project that includes a plurality of interdependent tasks organized in a hierarchy, comprising the steps of:
defining the plurality of tasks and storing the defined plurality of tasks in a database stored in a server that is selectively and remotely accessible over a computer network, each of the plurality of tasks having a status associated therewith;
defining a first dependency relationship between each of the defined plurality of tasks to define the hierarchy of tasks **and storing the defined first dependencies in the database;**
enabling remote retrieval of the status from the database over the computer network and remote updating of the status of any of the plurality of tasks over the computer network;
enabling remote definition of one of an Issue, a Change Request and a Change Order, the Issue identifying a problem within an identified one of the defined plurality of tasks whose resolution is to be tracked and whose resolution is necessary for the identified task to be completed, the Change Request identifying at least one step to be taken pending authorization to resolve the Issue and the Change Order identifying authorized steps to resolve the Issue;

storing the defined one of the Issue, Change Request and Change Order in the database; and enabling remote definition of at least one second dependency relationship between the defined Issue, Change Request or Change Order and the identified task such that the defined one of the Issue, Change Request and Change Order is integrated into the hierarchy of tasks without changing the defined first dependencies and storing the defined second dependency in the database.

For example, it would be impossible to carry out the above claimed steps solely “in the mind of the user” or solely using a “pencil and paper”, as advanced in the outstanding Office Action.

Amended independent claim 19 is also reproduced herein for the Examiner’s convenience – once again, the underlined and bolded text highlight the recitations in that fall within the technological arts:

19. A computer-implemented method of participating in a project that includes a plurality of interdependent tasks organized in a hierarchy, comprising the steps of:
accessing a remote database over a computer network, the database storing:
a definition of the plurality of tasks,
a status associated with each of the defined tasks, and
a first dependency relationship between each of the defined plurality of tasks;
updating of the status of at least one of the plurality of tasks over the computer network;
defining and causing to be stored in the database at least one of an Issue, a Change Request and a Change Order, the Issue identifying a problem within an identified one of the plurality of tasks whose resolution is to be tracked and whose resolution is necessary for the identified task to be completed, the Change Request identifying at least one step to be taken pending authorization to resolve Issue and the Change Order identifying authorized steps to resolve the Issue; and
defining at least one second dependency relationship between the defined Issue, Change Request or Change Order and the identified task such that the defined one of the Issue, Change Request and Change Order is integrated into the hierarchy of tasks without changing the defined first dependencies and causing the defined second dependency to be stored in the database.

Likewise, the subject matter of amended independent claim 19 resides squarely within the technological arts, and cannot be carried out in one’s mind or using pencil and paper. Indeed, it is not believed to be possible to effectively access a database using pencil and paper or to carry out the steps recited herein. The claim, therefore, is believed to define subject matter that passes muster under §101.

The same holds true for independent claim 37:

37. (Currently Amended) A computer system configured for managing a project timeline that includes a plurality of interdependent tasks organized in a hierarchy, comprising:
at least one processor;
at least one data storage device;
a plurality of processes spawned by said at least one processor, the processes including processing logic for:
defining the plurality of tasks and storing the defined plurality of tasks in a database stored in a server that is selectively and remotely accessible over a computer network, each of the plurality of tasks having a status associated therewith;
defining a first dependency relationship between each of the defined plurality of tasks to define the hierarchy of tasks and storing the defined first dependencies in the database;
enabling remote retrieval of the status from the database over the computer network and remote updating of the status of any of the plurality of tasks over the computer network;
enabling remote definition of one of an Issue, a Change Request and a Change Order, the Issue identifying a problem within an identified one of the defined plurality of tasks whose resolution is to be tracked and whose resolution is necessary for the identified task to be completed, the Change Request identifying at least one step to be taken pending authorization to resolve the Issue and the Change Order identifying authorized steps to resolve the Issue;
storing the defined one of the Issue, Change Request and Change Order in the database; and
enabling remote definition of at least one second dependency relationship between the defined Issue, Change Request or Change Order and the identified task such that the defined one of the Issue, Change Request and Change Order is integrated into the hierarchy of tasks without changing the defined first dependencies and storing the defined second dependency in the database.

As shown, the bolded and underlined material in amended independent claim 37 represents much more than mere intended or nominal use of a component within the technological arts. Again, such method is not susceptible to be performed within one's mind or using only a paper and pencil.

Amended independent claim 55 is given similar treatment herein below, by bolding and underlining the terms therein that are within the technological arts. As the Office can see, such terms represent more than just §101 window dressing and form an integral part of the claim and recited embodiment:

55. A machine-readable medium having data stored thereon representing sequences of instructions which, when executed by computing device, causes

said computing device to manage a project timeline that includes a plurality of interdependent tasks organized in a hierarchy by performing the steps of:
defining the plurality of tasks and storing the defined plurality of tasks in a database stored in a server that is selectively and remotely accessible over a computer network, each of the plurality of tasks having a status associated therewith;
defining a first dependency relationship between each of the defined plurality of tasks to define the hierarchy of tasks and storing the defined first dependencies in the database;
enabling remote retrieval of the status from the database over the computer network and remote updating of the status of any of the plurality of tasks over the computer network;
enabling remote definition of one of an Issue, a Change Request and a Change Order, the Issue identifying a problem within an identified one of the defined plurality of tasks whose resolution is to be tracked and whose resolution is necessary for the identified task to be completed, the Change Request identifying at least one step to be taken pending authorization to resolve the Issue and the Change Order identifying authorized steps to resolve the Issue;
storing the defined one of the Issue, Change Request and Change Order in the database; and
enabling remote definition of at least one second dependency relationship between the defined Issue, Change Request or Change Order and the identified task such that the defined one of the Issue, Change Request and Change Order is integrated into the hierarchy of tasks without changing the defined first dependencies and storing the defined second dependency in the database.

Amended independent claim 55, therefore, defines an article of manufacture (the computer readable medium) that includes the recited sequences of instructions which, when executed by a computing device, cause the computer to carry out the claimed method. Such claims (sometimes known as Beauregard claims) have been routinely granted by the Office for many years now. Such an article of manufacture is well within the purview of section 101 of the Patent Act.

Reconsideration and withdrawal of the 35 USC §101 rejections are, therefore, believed to be fully warranted and are, therefore, respectfully requested.

Claims 1-5, 7-24, 26-41, 43-59 and 61-72 were rejected as being anticipated by Microsoft Project 2000 as evidenced by three different publications.

At the outset, the applicant submits that 35 USC §102(b), reproduced herein below, is not the appropriate basis for rejecting the claims.

35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.
A person shall be entitled to a patent unless -

...

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

Indeed, it is not believed that Microsoft Project 2000, a computer application is a "printed publication" within the meaning of §102(b). As this reference is neither a printed publication nor a patent, §102(b) is unavailable as the basis for anticipation.

Moreover, even if, *arguendo*, the reference is available under §102(b) – which it is not, the MPEP allows multiple references to be used in a section 102 rejection in only three enumerated conditions, none of which apply here:

2131.01 Multiple Reference 35 U.S.C. 102 Rejections

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an "enabled disclosure;"
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

In this case, the A, B and C references are not used to show enablement of Microsoft Project 2000 and have not used by the Office to explain the meaning of any term within Microsoft Project 2000. This leaves (C), or showing that a characteristic not disclosed in the reference is inherent. The Office is urged to carefully consider the language of (C): to use multiple references under §102, the multiple references must be used to show that a characteristic not disclosed in the reference is inherent. To date, the Office has not identified any characteristic that is not disclosed in Microsoft Project 2000. There are no features used by the Office in its rejection that are "not disclosed" in Microsoft Project 2000. Moreover, the Office has not asserted the inherency of any characteristic that was not disclosed, as required under the PTO's own guidelines. Thus, the

rejection of the claims over the Microsoft Project 2000 so-called reference fails and must be withdrawn.

However, assuming, again *arguendo*, that a) the Microsoft Project 2000 is a "printed publication" under section 102 and that three references may be combined to bolster the Office's use of §102(b) (both of which the applicant disputes), it is respectfully submitted that the Office must withdraw its rejections in view of the amendments to the claims made herein to better define the claimed embodiments of the present invention.

Indeed, the Microsoft Project 2000 nowhere teaches, as variously recited in each of the amended independent claims:

enabling remote definition of one of an Issue, a Change Request and a Change Order, the Issue identifying a problem within an identified one of the defined plurality of tasks whose resolution is to be tracked and whose resolution is necessary for the identified task to be completed, the Change Request identifying at least one step to be taken pending authorization to resolve the Issue and the Change Order identifying authorized steps to resolve the Issue;

storing the defined one of the Issue, Change Request and Change Order in the database; and

enabling remote definition of at least one second dependency relationship between the defined Issue, Change Request or Change Order and the identified task such that the defined one of the Issue, Change Request and Change Order is integrated into the hierarchy of tasks without changing the defined first dependencies and storing the defined second dependency in the database.

Indeed, Microsoft Project 2000, as evidenced by the three references A, B and C does not teach any ability to define an Issue, Change Request and/or Change Order with respect to an identified task. As recited in the independent claims, the Issue identifies a problem whose resolution is to be tracked and whose resolution is necessary for the identified task to be completed. Moreover, the amended independent claims each specify that the defined Issue/Change Request/Change Order is integrated into the hierarchy of tasks without changing the first dependencies (those between the defined plurality of tasks). In other words, Microsoft Project 2000 does not teach any means of defining an Issue or a Change Request (that identifies the steps to be

taken to resolve the Issue) or a Change Order (that identifies authorized steps to resolve the Issue), nor any means of integrating the same into a hierarchy of tasks without changing the existing dependencies between the tasks. See, for example, Fig. 2 of the present application and Issue₂₁₂ for an illustration of this claimed subject matter. This alone warrants reconsideration and withdrawal of the applied anticipation rejection of the claims. The same is, therefore, respectfully requested.

Amended claim 6, for example, recites that "the problem identified by the Issue is a problem that was previously unidentified at the time when the plurality of tasks were defined." In this respect, the Office makes improper use of inherency. Indeed, the Office states that unforeseen items are "old and very well known and a key aspect of any project management effort/activity. At the outset, the applicants do not claim unforeseen items or activities. What is claimed is integrating a newly defined Issue/Change Request/Change Order into the hierarchy of tasks without changing the existing dependency relationships between the tasks. The Office's use of inherency, therefore, is misplaced. Moreover, if the claimed subject matter was a "key aspect of any project management effort/activity", surely such would have been covered in exhausting detail in any one or all three of the references used to bolster the Office's use of Microsoft Project 2000 under §102(b). The only allowable bases for the use of inherency are explored below, as they apply to the case at hand.

The Examiner's reliance upon inherency is misplaced, in error and does not conform with the USPTO's own standards concerning inherency:

"The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)(affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)."

Section 2112 of the MPEP (from which the passage above was taken) defines the standards to be followed by USPTO Examiners when formulating rejections based on inherency and clearly defines the Examiner's burden of proof. Each of the MPEP §2112 standards for inherency will now be addressed in turn.

"Something Which Is Old Does Not Become Patentable Upon The Discovery Of A New Property: The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)."

In the present case, however, no "new property" is claimed. What is claimed, on the other hand, is **structure and method steps**, namely an "methods, systems and media for managing project timelines". Moreover, the pending claims do not recite a "new use, new function or unknown property" that is inherently present in the prior art. Indeed, a structure that is not disclosed in the cited reference cannot be said to have a property, use or function – new or otherwise.

"A Rejection Under 35 U.S.C. 102/103 Can Be Made When The Prior Art Product Seems To Be Identical Except That The Prior Art Is Silent As To An Inherent Characteristic: Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, 35 U.S.C. 102/103 rejection is appropriate for these types of claims as well as for composition claims."

In the present case, however, the claims do not recite some "inherent" characteristic of Microsoft Project 2000 – one in which Microsoft Project 2000 "is silent". Indeed, if such function or capability were present in Microsoft project 2000, surely it would have been discussed and explained in all three of the reference applied in the §102(b) rejection – or in at least one of them. However, none of these references teach or disclose integrating a newly

defined Issue/Change Request/Change Order into the hierarchy of tasks without changing the existing dependency relationships between the tasks, as claimed herein.

"Examiner Must Provide Rationale Or Evidence Tending To Show Inherency:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted)(The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.)" (Emphasis Added).

The situation here is similar to the facts in the *In re Robertson* case cited in the MPEP above, in that each of the A, B and C references demonstrably fails to expressly or inherently disclose integrating a newly defined Issue/Change Request/Change Order into a hierarchy of tasks without changing the existing dependency relationships between the tasks, as claimed. It is further submitted that the Examiner has presented no evidence tending to show that persons of skill in this art would necessarily recognize the inherent presence of such function or capability in Microsoft Project 2000. The MPEP continues:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)".

The Examiner, in this case, has failed to provide such a basis in fact and/or any technical reasoning to support his contention that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The Examiner, instead, has relied on a conclusory

statement that "the ability to complete a project is in many ways dependent on the project's ... ability to manage unanticipated items ... which inevitably occur". Although that statement rings true and sounds reasonable, it does not support the use of inherency. Indeed, although unexpected items do, in fact, occur in large projects, it is only the claimed embodiments that define the methods, systems and media for dealing with such unexpected occurrences. In other words, it is only the presently claimed embodiments, and not Microsoft Project 2000, that provides a solution to the well known problem of how to manage unexpected occurrences within a project.

Section 2112.02 of the MPEP provides detailed guidance relative to inherency and process (method) claims:

"2112.02 Process Claims

PROCESS CLAIMS - PRIOR ART DEVICE ANTICIPATES A CLAIMED PROCESS IF THE DEVICE CARRIES OUT THE PROCESS DURING NORMAL OPERATION

Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) (The claims were directed to a method of enhancing color effects produced by ambient light through a process of absorption and reflection of the light off a coated substrate. A prior art reference to *Donley* disclosed a glass substrate coated with silver and metal oxide 200-800 angstroms thick. While Donley disclosed using the coated substrate to produce architectural colors, the absorption and reflection mechanisms of the claimed process were not disclosed. However, King's specification disclosed using a coated substrate of Donley's structure for use in his process. The Federal Circuit upheld the Board's finding that "Donley inherently performs the function disclosed in the method claims on appeal when that device is used in 'normal and usual operation' " and found that a *prima facie* case of anticipation was made out. *Id.* at 138, 801 F.2d at 1326. It was up to applicant to prove that Donley's structure would not perform the claimed method when placed in ambient light.). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) (Applicant claimed a process for preparing a hydrolytically-stable zeolitic aluminosilicate which included a step of "cooling the steam zeolite ... at a rate sufficiently rapid that the cooled zeolite exhibits a X-ray diffraction pattern" All the process limitations were expressly disclosed by a U.S. patent to Hansford except the cooling step. The court stated that any sample of Hansford's zeolite would necessarily be cooled to facilitate subsequent handling. Therefore, a *prima facie* case under 35 U.S.C. 102/ 103 was made. Applicant had failed to introduce any evidence comparing

X-ray diffraction patterns showing a difference in cooling rate between the claimed process and that of Hansford or any data showing that the process of Hansford would result in a product with a different X-ray diffraction. Either type of evidence would have rebutted the *prima facie* case under 35 U.S.C. 102. A further analysis would be necessary to determine if the process was unobvious under 35 U.S.C. 103.); *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993) (The Board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A U.S. patent to *Dart* disclosed inoculation using *P. cepacia* type Wisconsin 526 bacteria for protecting the plant from fungal disease. Dart was silent as to nematode inhibition but the Board concluded that nematode inhibition was an inherent property of the bacteria. The Board noted that applicant had stated in the specification that Wisconsin 526 possesses an 18% nematode inhibition rating.)."

Again, it is the properties or functions of a claimed apparatus that may be held to be inherent in an applied reference, when the product disclosed in the applied reference and the claimed invention are the same. Inherency may not be used or relied upon when the claims recite structures that are not found or suggested in the applied reference. The basis given for the inherency, in the outstanding Office Action, is that unforeseen items are "old and very well known... and a key aspect of any project management/activity". However, this statement, without more, does not support the Office's contention that Microsoft Project 2000 is inherently able to integrate a newly defined Issue/Change Request/Change Order into the hierarchy of tasks without changing the existing dependency relationships between the tasks, as claimed herein. Surely if such had been a feature of Microsoft Project 2000, Microsoft would not have kept it a secret - a so-called "undocumented feature" This deficiency alone is believed to render the Examiner's inherency argument fatally defective, by the USPTO's own standards. Therefore, no "sound basis for believing that the products or methods of the applicant and the prior art are the same" has been advanced by the Examiner, as required by the PTO's own guidelines for examining patent applications. It is submitted that inherency may not be used to circumvent or avoid the strict requirements of 35 USC §102, in which each and every claimed structure must be

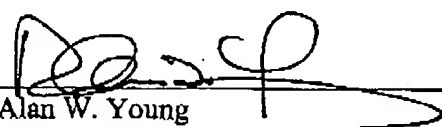
present in a single reference. In view of the foregoing, reconsideration and withdrawal of both the inherency argument and the §102 rejection of the above-identified claims are respectfully requested.

It is believed, therefore, that the present amendment overcomes the outstanding rejections and places this application in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should Examiner Jarrett have any further questions regarding this amendment or the application in general, he need only call the undersigned, and whatever is needed will be done at once.

Respectfully submitted,

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